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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/203,166 12/01/98 BEALL

G CGW-235.1

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MM42/0730

EXAMINER

ULLAH, A

ART UNIT

PAPER NUMBER

2874

7

DATE MAILED: 07/30/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Ap

on No.

Applicant(s)

203,166

Weidman et al.

Ex.

r

Group Art Unit

Akm Enayet Ullah

2874



☒ Responsive to communication(s) filed on May 20, 1999

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for minor formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 19 Qu. 1, 11; 453 O.G. 213.

A shortened statutory period for response to this action is set forth in 37 CFR 1.136(a). Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extension of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claims

☒ Claim(s) 41-61

Of the above, claim(s) \_\_\_\_\_

☒ Claim(s) 41-50 and 54-59

☒ Claim(s) 51, 53, 60, and 61

☒ Claim(s) 52

☐ Claims \_\_\_\_\_

### Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_, is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of priority documents have been received.

☐ received.

☐ received in Application No. (Series Code, Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper(s) \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-102

Formal matters, prosecution as to the merits is closed under 35 U.S.C. § 119(a)-(d). 11; 453 O.G. 213.

A shortened statutory period for response to this action is set forth in 37 CFR 1.136(a). Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extension of time may be obtained under the provisions of 37 CFR 1.136(a).

\_\_\_\_\_ is/are pending in the application.

\_\_\_\_\_ is/are withdrawn from consideration.

\_\_\_\_\_ is/are allowed.

\_\_\_\_\_ is/are rejected.

\_\_\_\_\_ is/are objected to.

\_\_\_\_\_ are subject to restriction or election requirement.

Review, PTO-948.

to by the Examiner.

is ☐ approved ☐ disapproved.

under 35 U.S.C. § 119(a)-(d).

of priority documents have been received.

(r) \_\_\_\_\_.

International Bureau (PCT Rule 17.2(a)).

under 35 U.S.C. § 119(e).

\_\_\_\_\_ 02

--- SEE OFFICE ACTION ON

FOLLOWING PAGES ---

Art Unit:

### *Specification*

**Applicant's cooperation is requested** in correcting any errors of which applicant may become aware in the specification.

A restriction was made in this application on March 25, 1999 (Paper no. 4) in claims 1-40. Claims 1-40 have been canceled by an amendment. **Claims 41-61 are pending** in this application.

This application is a continuation of U.S. Application No. 09/101, 630 filed on July 14, 1998, which is the US national phase filing of PCT/US96/13062 filed on August 07, 1996, which claims the benefit under 35 USC 119 (e) of U.S. Provisional Application No.60/010,058, filed on January 16, 1996.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### *Drawings*

The drawings filed on December 01, 1998 are approved by the Draftsperson under 37 CFR 1.84 or 1.152. See the attached PTO-948.

Art Unit:

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 51 & 53 are rejected under 35 U.S.C. 102 (b) as being clearly anticipated by Material Chemistry and Physics, vol. 42, 1995 pages 214-215 by A.K. Chu et al.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103<sup>®</sup> and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 60-61 are rejected under 35 U.S.C. 103 (a) as being unpatentable over MacDonald et al. (U.S.P.NO. 5,367,589).

Art Unit:

MacDonald et al disclose a package for an optical fiber that controls the amount of strain to which the fiber is subjected. MacDonald further disclose a method for placing an optical fiber with at least one grating written therein into a package. Column 1 and 2 of Mac Donald et al clearly disclose all the feature of the invention. **It is noted that MacDonald et al has inherently negative coefficient of thermal expansion. For details see column 2, lines 46-65 of MacDonald et al.**

It would have been obvious to one of ordinary skill in the art at the time the invention was made to attach the fiber to a substrate instead of a package 24 since it is known to attach of fiber to a substrate, as claimed, if desired since MacDonald et al teach the gist of the invention.

Evaluations of the level of ordinary skill in the art requires consideration of such factors as various prior art approaches, types of problems encountered in the art, rapidity with which innovations are made, sophistication of technology involved, educational background of those actively working in the field, commercial success, and failure of others.

Art Unit:

The “person having ordinary skill” in this art has the capability of understanding the scientific and engineering principles applicable to the claimed invention. The evidence of record including the references and/or the admissions are considered to reasonably reflect this level of skill.

*Claim Objected*

Claim 52 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Claims Allowed*


Claims 41-50 and 54-59 are allowed over the prior art as of record.

Art Unit:

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner **Akm Enayet Ullah** whose telephone number is (703) 308-4885.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

  
**AKM ENAYET ULLAH**  
**PRIMARY EXAMINER**  
**TECH. CENTER 2874**